

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

MS#172026.01 (5211)

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Application Number

09931211

Filed

2001-08-16

First Named Inventor

Mathrubootham Janakiraman

Art Unit

2455

Examiner

Asad M. Nawaz

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Barbara A. Wilkey/

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Barbara A. Wilkey

Signature

Typed or printed name

☒ attorney or agent of record.

Registration number 62,986

314/345-7000

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

2008-11-25

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Mathrubootham Janakiraman et al.

Art Unit 2155

Serial No. 09/931,211

Filed August 16, 2001

Confirmation No. 2348

For METHOD AND SYSTEM FOR SELECTIVELY VIEWING PARTICIPANTS OF A
MULTIMEDIA NETWORK CONFERENCE

Examiner Asad M. Nawaz

November 25, 2008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

TO THE COMMISSIONER FOR PATENTS:

Applicants hereby request review of the Office's rejection of claims 10-16, 18 and 24-35 as set forth in the final Office action dated May 30, 2008 and Advisory Action dated October 1, 2008. A Notice of Appeal is being filed concurrently herewith.

While no fees are believed due with respect to this Request, the Commissioner is authorized to charge any fees due to Deposit Account No.19-1345.

ARGUMENTS

The claims stand rejected under Sandvoss in view of Okamura.¹ For each of the pending claims discussed below, the Examiner's rejection is clearly erroneous and fails to establish a *prima facie* case of obviousness. In particular, (1) the Examiner has failed to provide articulated reasoning to support obviousness and (2) Sandvoss and Okamura cannot be combined to produce the claimed invention, and even if combined, Sandvoss and Okamura do not teach each of the features of the claimed invention.

Claim 10 is directed to a multimedia conferencing system comprising, among other things, (1) a participant selection control parameter having a static display constraint on a selection of a video signal, (2) a participant state table indicating an activity state variable for each participant wherein the activity state variable includes values and statistics associated with the participant's video signal and audio signal; and (3) a bridge server connected to the participants through a network.² The bridge server updates the activity state variable for each participant in the participant state table, periodically computing a weight of said each participant based on the activity state variable and the participant

¹ Final Office action, dated May 30, 2008, page 3.

² Amendment I, filed September 10, 2008, pages 2-3.

selection control parameter. In addition, the bridge server identifies a participant having a highest weight among the participants, and selects from the received multimedia conferencing data the video signal corresponding to the identified participant having the highest weight for transmission to the client for viewing. Claim 24 recites a corresponding method.³

1. The Office Action Fails to Provide Articulated Reasoning to Support Obviousness

Firstly, Applicant's representative repeatedly tried to contact the Examiner to request clarification of the rejection based on Okamura and to discuss the need for a new Office action. The Examiner did not return phone calls from Applicant's representative Frank Agovino and, when Mr. Agovino reached him, the Examiner refused a telephone conference. Thus, we have tried to work with the Examiner to clarify the faulty rejection, but he refused. And, the Examiner failed to enter the Applicants' amendment to claims 10 and 24 responding to a 35 U.S.C. § 112 rejection stating the amendment raised new issues requiring further search.⁴

The final Office action admits that "Sandvoss does not explicitly indicate providing a participant state table indicating an activity state variable for each participant and assigning a predetermined weight to at least a participant for duration previously set."⁵ Although the final Office action states that "Okamura teaches providing a participant state table...,"⁶ the final action fails to explain how Sandvoss and Okamura support an obviousness rejection. For example, there is no mention in the final action as to: (1) how the table of Okamura is related to Sandvoss or (2) how Okamura could be combined with Sandvoss or (3) how Okamura teaches modifying Sandvoss. As a minimum, the final rejection fails to provide some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.⁷ Consequently, the rejection must be withdrawn.

In particular, the Examiner asserts Okamura teaches providing a participant state table indicating an activity state variable for each participant and assigning a predetermined weight to at least a participant for a duration previously set.⁸ The Examiner jumps to the conclusion that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Okamura into those of Sandvoss to make the system better organized and that the system will execute more efficiently if all the data were to be gathered into one data structure rather than

³ Amendment I, filed September 10, 2008, pages 4-5.

⁴ Advisory Action, dated October 1, 2008, pages 2 and 3.

⁵ Final Office action, dated May 30, 2008, page 4.

⁶ Final Office action, dated May 30, 2008, page 4.

⁷ MPEP 2143, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

⁸ Final Office action, dated May 30, 2008, page 4.

multiple ones.⁹ However, Applicants' submit the Examiner conclusion fails to articulate any reasoning with some rational underpinning on how the cited references of Sandvoss and Okamura could be combined.

Specifically, the Examiner has failed to articulate how the activity state taught by Okamura may be combined with Sandvoss. In this case, the differences in structure and function of the cited references are great and significant and cannot be combined as they are non-analogous art.¹⁰ Sandvoss discloses teleconferencing where the multimedia streams with the highest priority level streams are actively transmitted and the weight used to determine priority is calculated from substream signals that are input to a process.¹¹ In contrast, the activity state of Okamura is analyzed by an activity state registering unit to either (1) register the name of user with the information activity management unit or (2) register a distribution unnecessary condition based on the distribution reason recorded inside the notified information ID with the distribution unnecessary condition storage unit.¹² As such, the references are non-analogous prior art because they do not share a common structure or function. Thus, the activity states of Sandvoss and Okamura are different and cannot be combined without more explanation for the motivation or the manner of their combination.

Moreover, there is no discussion in the Office action regarding how the activity state of Okamura can teach or suggest the claimed state **table**, or how the activity state of Okamura teaches or suggests the claimed activity state variable, much less the claimed activity state variable **for each participant**, and much less the claimed assignment of **a predetermined weight** to at least a participant **for a duration previously set**. Instead, the cited portions of Okamura teach an activity state registering unit for registering users in an item of user in the information activity management unit when notified by the users that the information was useful.¹³ A close reading of Okamura reveals that a name or distribution condition registration occurs. When a user notifies the system that the information could be effectively utilized, the activity state registering unit **registers a name** of the user in the item of "user" within the information activity management unit specified by the notified information ID.¹⁴ On the other hand, when the user notifies the system that the information is not required, the activity state registering unit **registers the** distribution unnecessary **condition** with the

⁹ Final Office action, dated May 30, 2008, page 4.

¹⁰ To rely on a reference under 35 U.S.C. 103, it must be analogous prior art. And, the Court has found "the similarities and differences in structure and function of the inventions [to] carry far greater weight" in determining what is analogous prior art. MPEP 2141.01(a) citing, *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973).

¹¹ Amendment I, filed September 10, 2008, page 11; Sandvoss, column 3, lines 53-58.

¹² Amendment I, filed September 10, 2008, page 11; Okamura, column 10, lines 31-47.

¹³ Amendment I, filed September 10, 2008, page 11; Okamura, column 2, lines 37-41.

¹⁴ Amendment I, filed September 10, 2008, page 11; Okamura, column 10, lines 31-47.

distribution unnecessary condition storage unit based on the distribution reason.¹⁵ There is no discussion in these referenced portions of Okamura or elsewhere related to the recited invention, e.g., providing a participant state table indicating an activity state variable (including values and statistics associated with the participant's video signal and audio signal) for each participant and assigning a predetermined weight to at least a participant for a duration previously set, as recited in claim 10.

As such, the Examiner has committed a clear error¹⁶ by failing to provide a rational underpinning to support how the activity state of Okamura may be combined with Sandvoss to make obvious the activity state variable recited in claim 10. Therefore, the rejection must be withdrawn. To the extent claim 24 includes the same features as claim 10, the Examiner committed clear error for the same reasons.

2. Sandvoss and Okamura Cannot Be Combined to Produce the Claimed Invention

There is no logical way to combine the weight of Sandvoss with the activity state of Okamura, to provide a participant state table indicating an activity state variable for each participant and assigning a predetermined weight to at least a participant for a duration previously set, as recited in claim 10. As explained above, Sandvoss discloses conferencing where the multimedia streams with the highest priority level streams are actively transmitted and the weight used to determine priority is calculated from substream signals that are input to a process. And, Okamura teaches that information received from the system as to the usefulness of the information previously received is used to determine if the user will receive similar information in the future. The condition that Okamura would add to the system of Sandvoss is based on the user feedback which indicates that the user finds the information useful and would like to receive similar information (or that the user does not find the information useful and would not like to receive similar information). As such, the activity state (user feedback) of Okamura cannot be added to the system taught by Sandvoss to provide a participant state table indicating an activity state variable (including values and statistics associated with the participant's video signal and audio signal) for each participant and assigning a predetermined weight to at least a participant for a duration previously set.

Assuming without agreeing that Sandvoss and Okamura can be combined, their combination does not teach or suggest the features of the claimed invention. At most, the combination of Okamura and Sandvoss would provide an activity state indicating user feedback (activity state). In addition, as noted above, Okamura does not cure the defects of Sandvoss since it does not teach a state table, much

¹⁵Amendment I, filed September 10, 2008, page 11; Okamura, column 10, lines 31-47.

¹⁶ MPEP 2143, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

less a state table indicating an activity state variable **for each** participant, much less assigning a **predetermined weight** to at least a participant **for a duration previously set**. In other words, Okumura does not solve the admitted deficiencies of Sandvoss. Thus, the Examiner has committed clear error and failed to make a *prima facie* case of obviousness. To the extent claim 24 includes the same features as claim 10, the Examiner committed clear error for the same reasons.

CONCLUSION

Applicants submit that the rejection is so faulty, that prosecution must be re-opened. Applicants are more than willing to discuss ways to clarify the claim language to avoid the overbroad and weak interpretations of the cited prior art.

For at least these reasons, Applicants respectfully request allowance of the pending claims.

Respectfully submitted,

/Barbara A. Wilkey/

Barbara A. Wilkey, Reg. No. 62,986
SENNIGER POWERS LLP
100 North Broadway, 17th Floor
St. Louis, Missouri 63102
(314) 345-7000